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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,355	01/09/2004	Aaron L. Jestice	FO025.0001/P001	2786
24998 7590 04/23/2008 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				
EXAMINER PALABRICA, RICARDO J				
ART UNIT		PAPER NUMBER		
3663				
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04/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/753,355

Applicant(s)

JESTICE, AARON L.

Examiner

Rick Palabrica

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-26, 29-32, 34, 36-38, 40-44 and 46-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-26, 29-32, 34, 36-38, 40-44, and 46-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's 3/20/08 Amendment, which directly amended independent claims 23, 24 and 29, canceled claim 45, and traversed the rejection of claims in the 2/28/08 Office action, is acknowledged

Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 23-26, 29-32, 34, 36-38, 40-44, and 46-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 23 recites the limitation:

"determining that a confounder is present in the object when the relative atomic percentages of elements comprising the object are not substantially similar to the relative percentages of elements associated with known explosives and controlled substances." Underlining provided.

There is neither an adequate description not enabling disclosure as to how and in what manner the claim precludes erroneous results on the presence of a confounder. For example, in the above limitation, it is possible that "the relative atomic percentages of elements comprising the object are not substantially similar to the relative percentages of elements associated with known explosives and controlled substances" may be due NOT to the presence of a confounder but to the presence of non-confounders, e.g., ordinary personal articles such as clothes that have elements not associated with explosives or controlled substances. Thus, the claim does not prevent the method from generating false positive results of presence of a confounder.

Claim 24 recites the limitations:

"subjecting the plurality of analyses to a hierarchy of classifiers to determine if at least one of an explosive or controlled substance or confounder is present in the object; and pulsing the neutron sources sequentially after determining that an explosive or controlled substance is present in the object." Underlining provided.

As presently set forth, the method does not yield the desired result of detecting explosives or controlled substances when the analyses to a hierarchy of classifiers determines that ONLY a confounder is present. No further step is taken to make a positive determination regarding the presence of an explosive or controlled substance, after such confounder-only identification has been made.

Claim 49 does not yield the desired result of detecting explosives or controlled substances when the comparison of decomposed signature data determines that ONLY a confounder is present. . No further step is taken to make a positive determination of the presence of an explosive or controlled substance, after such confounder-only identification has been made.

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3. Claim 23-26, 29-32, 34, 36-38, 40-44, and 46-50 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Elements critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The missing elements are as follows: a) claim 23 – the element that ensures the method does not generate false positive results of presence of a confounder; b) claims 24 and 49 – the element taken to make a positive determination of the presence of an explosive or controlled substance, after a confounder-only identification.

4. Claims 23-26, 29-32, 34, 36-38, 40-44, and 46-50 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a) claim 23 – the step that ensures the method does not generate false positive results of presence of a confounder; b) claims 24 and 49 – the step to make a positive determination of the presence of an explosive or controlled substance, after a confounder-only identification.

Claim Rejections - 35 USC § 101

5. Claims 23-26, 29-32, 34, 36-38, 40-44, and 46-50 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. See discussion in section 2 above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 571-272-6880. The examiner can normally be reached on 6:00-4:30, Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 18, 2008

/Rick Palabrica/
Primary Examiner, Art Unit 3663